

## **REMARKS**

### **Status of the Claims**

Claims 1-23 are pending in this application.

Claims 1-10 are rejected.

Claims 1-10 have been canceled, without prejudice.

Claims 11-23 are new. Support for these new claims can be found throughout the specification, claims, and drawings, as originally filed.

### **Specification Objections**

The Office Action objected to the title of the invention indicating that it was not descriptive. It was suggested that the title be amended to read "Proximity Switch for Automotive Interior Mirror Module." Applicant submits with this response a substitute specification which includes an amendment to the title following the suggestion made in the Office Action. Applicant respectfully requests removal of the objection to the title.

The Office Action also objected to the Abstract section of the specification. It was indicated that the wording in the Abstract used phrases that can be implied and referred to purported merits or speculative applications of the invention. Applicant has submitted with this response a substitute specification which includes a re-drafted abstract which Applicant believes to be in compliance with the rules. Applicant respectfully requests removal of the objection to the abstract.

### **Drawing Objections**

The Office Action objected to the drawings on several grounds pursuant to 37 C.F.R. 1.84 (p)(4). The Office Action indicated that reference character 40 had been

used to designate both a “reading lamp” and “evaluation electronics;” reference character 21 was used to designate “sensor” and “proximity sensor;” reference character 12 was used to designate “mirror base” and “lower left corner region;” and reference character 25 was used to designate “sensor” and “capacitive proximity sensor.” The Office Action further objected to the drawings pursuant to 37 C.F.R. 1.84 (p)(5) because reference numeral 4 in the description was not in the drawings. Applicant has corrected all of the above mentioned objections by making amendments to the specification. Pursuant to 37 C.F.R. 1.121 (b)(3) Applicant submits a marked-up substitute specification and a clean copy of the substitute specification wherein all of the above issues have been addressed.

With regard to the objection of reference character 40 being used to designate “evaluation electronics (40)” the substitute specification changes the reference numeral “evaluation electronics (40)” to recite reference numerals 31, 35 which is the proper designation for “evaluation electronics.” See ¶ [0019]. With regard to reference character 21 being used to recite “proximity sensor (21)” Applicant has amended the specification so that it now recites “sensor 21.” See ¶s [0020], [0023], [0024], [0025]. With regard to reference character 12 being used to designate “mirror base (12)” Applicant has corrected the specification to recite “mirror base 15.” See ¶ [0025]. Upon review of the specification Applicant discovered that mirror base had been mistakenly labeled 12 when it should have been labeled 15. With regard to reference character 25 being used to designate a “capacitive proximity sensor (25)” Applicant has amended the term “capacitive proximity sensor (25)” to recite “sensor 25.” See ¶ [0025]. Since the specification amendments eliminate all of the drawing objections found in part three of the Office Action. Applicant respectfully requests removal of the objection to the drawings with respect to part three of the Office Action.

The Office Action also indicated that the drawings were objected to as failing to comply with C.F.R. 1.84(p)(5) because they do not include reference signs mentioned in the description, mainly reference numeral 4. Applicant submits that the amendments made to the specification, which are shown in the submitted substitute specification have corrected the objection with respect to label 4. The specification has been amended so that reference numeral 4 has been deleted and reference numeral 40 has been added in its place because the reading lamp should have been labeled 40 but was mistakenly labeled 4. See ¶ [0021]. Applicant respectfully requests removal of the drawing objection to reference numeral 4.

Applicant submits that the amendment to the specification does not add any new matter and respectfully requests removal of the objection to the drawings since the substitute specification now obviates the objection. Entry of the drawings as filed is respectfully requested since all drawing objections have been obviated by the substitute specification submitted herein.

**Rejection of Claims 1, 2, 6 and 8 Under 35 U.S.C. § 102(b)**

Claims 1, 2 and 6 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 5,880,538 to Schultz (hereafter Shultz). Additionally claim 8 stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 5,434,757 issued to Kashiwagi (hereafter Kashiwagi). Applicant submits that claims 1 through 10 of the current application have been cancelled; therefore, the rejection of claims 1, 2, 6 and 8 have been obviated by the cancellation of claims 1-10. However, Applicant will now discuss the patentability of new claims 11-23 in view of the Shultz and Kashiwagi patents individually.

New claim 11 is currently the only pending independent claim and claims 12-23 all depend either directly or indirectly from independent claim 11. With regard to Shultz the Office Action indicated that the elements of cancelled claim 1 directed to a housing and the element of the electronics being located internal or external to the housing were inherent. The Office Action also indicated that the limitation of the sensor being provided with a preferred directivity as recited in cancelled claim 6 was also inherent. The Office Action stated that “regarding the claimed switching device being used in an automotive interior mirror module, such recitations were considered to refer to the intended use of the claimed invention since such recitations fail to result in any structural difference between the claimed invention and the structure disclosed by Shultz...”

Applicant respectfully points out that “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9F. 3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993).” MPEP 2112 at p. 2100-52. In order to establish inherency extrinsic evidence must make it clear that the missing descriptive matter that is not present in a reference would be recognized by persons of ordinary skill. *In re Robertson*, 169 F. 3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999); See also MPEP 2112 at p.2100-52. It is further been stated that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Taking the above into consideration, the inherency argument made in the present Office Action does not appear to be well supported.

The present Office Action does not provide any basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Furthermore, Shultz only describes applications of the actuating device being used for exterior automotive applications such as windshield wipers and door locks. See Col. 1, Lines 6-10 and Abstract. Thus Schultz does not by itself present any extrinsic evidence for an interior mirror housing with electronics being inherent to the prior art. Without any further reasoning or extrinsic evidence there will be nothing inherent about the element of "a mirror housing of an automotive interior mirror module" or "an evaluation electronics unit disposed in said mirror housing..." as described in claim 11 of the present application, nor are these limitations disclosed by Schultz. Therefore Applicant submits that Schultz does not anticipate each and every element of new claim 11.

Additionally dependent claim 19 is dependent upon claim 11 and specifies that the sensor has a preferred directivity. The Office Action indicated that a sensor having preferred directivity would be inherent; however, the Office Action did not establish any basis of fact or technical reasoning to support a determination that a sensor with preferred directivity would flow from the prior art. Therefore, Applicant submits that claim 19 is not anticipated because of inherency. Additionally, since claim 19 is dependent on claim 11 Applicant submits that it is allowable since as stated above claim 11 is properly allowable. Claim 19 only adds further allowable features to the allowable base claim.

With regard to the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by Kashiwagi Applicant notes that new claim 21 contains similar limitations as original 8. However, new claim 21 is dependent upon independent claim 11, the only independent claim in the claim set. Therefore, in order for Kashiwagi to anticipate

dependent claim 21 it must also anticipate each and every element of independent claim 11.

Applicant does not believe that independent claim 11 is anticipated by the Kashiwagi reference. New independent claim 11 claims in pertinent part " a mirror housing of an automotive interior mirror module." The Kashiwagi reference is directed to controls mounted on a vehicle door trim, such as a vehicle armrest. Col. 1, Lines 5-11. Label 21 of Fig. 7, was pointed on in the Office Action as referring to a switch unit that is disposed within the vehicle armrest. Col. 3, Lines 16-27. Kashiwagi does not disclose the switch in or related to a mirror housing. For this reason Kashiwagi does not anticipate each and every element of new claim 11.

The Office Action also indicated that the feature of "the electronics being located internal or external to the housing" is an inherent feature of Kashiwagi. As discussed above in order to rely on the theory of inherency an Examiner must provide a basis in fact or technical reasoning to support the determination that an allegedly inherent characteristic flows from the teaching of the applied prior art. *Ex parte Levy*, 17 USPQ 2d. 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action did not present any basis in fact or technical reasoning to support the determination that the electronics being internal or external to the mirror housing (as presented in new claim 11) was in fact an inherent characteristic that flowed from the teaching in the prior art. Kashiwagi certainly did not provide any extrinsic evidence supporting this teaching since Kashiwagi clearly discusses controls that are mounted in a vehicle door trim. Col. 1, Lines 5-11. Kashiwagi by itself fails to anticipate each and every element of new claim 11, therefore, new claims 11-23 are patentable in view of the Kashiwagi reference. Applicant respectfully requests removal of the rejection of the claims with respect to Kashiwagi and request allowance of new claims 11-23.

### **Rejection of Claims 3-5, 7, 9 and 10 Under 35 U.S.C. § 103**

Claims 3-5, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,538 issued to Schultz (hereafter Schultz) in view of U.S. Patent No. 5,820,245 issued to Desmond, et al. (hereafter Desmond).

Claims 3-5, 7, 9 and 10 have been cancelled and new claims 11-23 have been added. Applicant will now discuss the patentability of new claims 11-23 in light of Schultz in view of Desmond.

New claim 11 is the only independent claim in the claim set, therefore, the proposed combination of Schultz in view of Desmond must render independent claim 11 obvious in order for any of dependent claims 12-23 to be rendered obvious in view of the proposed combination.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d

899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). Applicant respectfully points out that the proposed combination of Schultz in view of Desmond is not properly combinable since there is no teaching or suggestion in the art to combine these references to arrive at the invention presented in new claims 11-23.

With regard to independent claim 11 Applicant points out that the primary reference, Schultz, does not teach or suggest a mirror housing of an automotive interior mirror module, nor does it teach or suggest an evaluation electronics unit disposed in the mirror housing. See claim 11 of the present application. The Schultz reference is directed to actuating devices for a variety of control applications such as windshield wipers and door locks. See Abstract. Applicant points out that all of the applications for the invention described in Schultz are for exterior automotive components and there is nothing to teach or suggest using the switching mechanism in the vehicle interior; nor is there anything that teaches or suggest associating the switching mechanism with a light. Desmond is directed to an interior rear view mirror assembly having a light with a mechanical switch. See Col. 4, Lines 37-46. There is nothing in the Desmond patent that teaches or suggests a switching process based upon the approach of a non metallic object toward at least one sensor as described in new claim 11. Furthermore, Desmond does not provide any motivation to combine the invention taught therein with the proximity sensor described in Schultz. Therefore, Applicant maintains that the proposed combination of Schultz and Desmond together will not render all the elements of independent claim 11 obvious. Since new claims 12-23 are all dependent upon claim 11, these claims will not be rendered obvious by the proposed combination of Schultz in view of Desmond since each of these claims are either dependent directly upon or ultimately dependent from independent claim 11. Therefore, Applicant respectfully



requests the removal of any rejections of new claims 11-23 by Schultz in view of Desmond. Applicant respectfully requests allowance of new claims 11-23.

### **CONCLUSION**

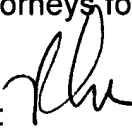
It is respectfully submitted that in view of the above amendments and remarks new claims 11-23, as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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Dated: January 14, 2005

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